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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/629,547	04/09/1996	TETSU TAKAHASHI	ATS-032-CON/	2519

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EXAMINER

LUONG, VINH

ART UNIT	PAPER NUMBER
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3682

DATE MAILED: 05/04/2004

#60

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

08/629,547

Applicant(s)

TAKAHASHI ET AL.

Examiner

Vinh T Luong

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 101-165 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 101-165 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.


Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 April 1996 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. 07/485,659.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


Vinh T. Luong
Primary Examiner

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

1. The Examiner's Answer on May 22, 2002 has been withdrawn in view of the Board's Remand to the Examiner on August 13, 2003. The following Office action takes place.
2. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: none of previously submitted declarations cover the new claims 101-165 filed on August 13, 2001. Therefore, it is not clear what specific error is being corrected. A new Declaration stating no deceptive intent to cover *all* amendments made during prosecution of the reissue application must be submitted. The new Declaration must state that at least one reissuable error being corrected. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.
3. Claims 101-165 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.
4. The following is a statement of reasons for the indication of allowable subject matter: the recapture rejection in the Examiner's Answer is withdrawn in the present reissue application in view of the following analysis based on *Ex parte Eggert et al.*, Appeal No. 2001-0790 (Bd. Pat. App. & Inter. May 29, 2003)(a precedential opinion of an expanded panel of the Board):

A. Original claim 11 and claim 16 were the same scope except that claim 16 included an additional limitation of a "reinforcing member." The reinforcing member further included a "space" portion limitation which permitted axial movement of the members. The claim language read:

"a reinforcing member for reinforcing said elastic plate at the secured portion at which said elastic plate is secured to said crankshaft, said reinforcing member defining a space between said elastic plate and said flywheel body." (Emphasis added).

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B. Claim 16 was cancelled and claim 11 (ultimately patent claim 1) was amended to include a reinforcing member wherein the "space" was defined by detailed structural limitations.

The amended claim language which defines the original broad "space" is as follows:

"wherein each said elastic plate, said flywheel body and said reinforcing member comprises a first portion, said first portion of said flywheel body being placed axially between said first portions of said elastic plate and said reinforcing member, and said first portion of said elastic plate, said flywheel body and said reinforcing member defining clearances for allowing said first portion of said flywheel body to move axially between said first portions of said elastic plate and said reinforcing member."
(Emphasis added).

C. Thus, the broad "space" limitation was surrendered in favor of specific structure which defined a " clearance" to permit the desired movement.

D. Claim 113 of the reissue application is similar to original application claim 16 but deletes the broad "space" limitation for different structural limitations (than the limitations added for patentability) to define the "space" needed for movement. The claim language which defines the "space" limitation in the reissue claim is as follows:

"wherein said reinforcing member has a radially extending portion which extends at least inwardly of said flywheel body, and wherein said elastic plate comprises a first portion, said first portion of said flywheel body being placed axially after said first portion of said elastic plate, and said first portions of said flywheel body and said elastic plate defining a first clearance and said flywheel body having a first free space on a side opposite of the first clearance for allowing said first portion of said flywheel body to move axially within the first clearance and the free space."

E. A parallel fact pattern exists for original application claims 18 and 14 (ultimately patent claim 8) and current reissue claim 128.

F. The reissue claims 113 and 128 broaden or change the detailed "space" limitations of respective patent claims 1 and 8 (amended original application claims 11,16 and 14,18), but are narrower than the broad "space" limitation of original application claims 11 and 14 which was surrendered. Thus, the reissue claims provide a narrowing of the canceled claims in the area of the surrender.

G. Thus, *Ex part Eggert, supra* applies, and the appealed rejection which is based on recapture is withdrawn by the examiner.

5. The proposed drawing correction filed on March 17, 1997 has been disapproved. However, the proposed drawing correction filed on May 20, 1997 and July 22, 1997 have been approved. See page 2 of the Office action on October 23, 1997 and page 2 of the Office action on October 29, 2001. Applicant is required to submit formal drawings which incorporate all of the approved changes. These formal drawings must be labeled as "Amended" or "New." See 37 CFR 1.173(b).

6. The interlineations or cancellations made in the specification or amendments to the claims could lead to confusion and mistake during the issue and printing processes. Accordingly, the portion of the specification or claims as identified below is required to be rewritten before passing the case to issue. See 37 CFR 1.125 and MPEP § 608.01(q).

A substitute specification and all of the cancelled and pending claims in compliance with 37 CFR 1.173(b) are required to be rewritten.

7. Applicant's amendment filed on August 13, 2001 necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See

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MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vinh T. Luong whose telephone number is 703-308-3221. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bucci can be reached on 703-308-3668. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Luong

April 30, 2004



Vinh T. Luong
Primary Examiner